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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) TKX-7123US									
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____		Application Number 09/997,034	Filed November 28, 2001								
		First Named Inventor Grieswald									
		Art Unit 2616	Examiner Hom, Shick C.								
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table><tbody><tr><td><input type="checkbox"/> applicant/inventor.</td><td>_____ /Michael J. Fogarty, III/ Signature</td></tr><tr><td><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td>_____ Michael J. Fogarty, III Typed or printed name</td></tr><tr><td><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>42,541</u></td><td>_____ 972-732-1001 Telephone number</td></tr><tr><td><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</td><td>_____ October 20, 2008 Date</td></tr></tbody></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<input type="checkbox"/> applicant/inventor.	_____ /Michael J. Fogarty, III/ Signature	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	_____ Michael J. Fogarty, III Typed or printed name	<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>42,541</u>	_____ 972-732-1001 Telephone number	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____	_____ October 20, 2008 Date
<input type="checkbox"/> applicant/inventor.	_____ /Michael J. Fogarty, III/ Signature										
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<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.											

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Grieswald	Docket No.:	TKX-7123US
Serial No.:	09/997,034	Art Unit:	2616
Filed:	November 28, 2001	Examiner:	Hom, Shick C.
For:	Circuit Arrangement for Testing a Communication System		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Pending independent claims 1 and 6 have been rejected in the Final Office Action mailed August 19, 2008 (“the Final Office Action”). The claims stand rejected under 35 U.S.C. § 103(a) as assertedly being unpatentable over a combination of Parker (U.S. Patent No. 5,822,520) and Chang (U.S. Patent No. 6,327,637). The claims, however, include limitations that are not taught or suggested by any of the cited references. Since these limitations are not shown in any of the references alone, they cannot be taught or suggested by the combination of references. Therefore, the claims are not obvious and should be allowed.

Claim 1 recites (emphasis added):

1. A circuit for testing a communication system that is subdivided into functional layers comprises **a port that allows communication by a test apparatus** directly with any layer that is higher than a first layer of the functional layers **without the communication previously having to pass through the first layer**.

Claim 6 recites (emphasis added):

6. A method for testing a switch for a telecommunication network that is subdivided into functional layers comprising the steps of:
providing the switch with **a circuit arrangement having a port that allows communication by a test apparatus** directly with any layer that is higher than a first layer of the functional layers **without the communication previously having to pass through the first layer**;
outputting response data from the port to the test apparatus; and
analyzing the response data by the test apparatus.

It is well-known that the claimed “first layer” is a physical layer.

The Final Office Action cites Parker as teaching a port that allows communication by a test apparatus, but admits that Parker does not teach communicating directly with a layer higher than a first layer without the communication passing through the first layer. (Final Office Action at 3-4.) The Final Office Action then points to Chang as teaching “that it is known to provide whereby the test apparatus communicate directly with any layer that is higher than a first layer of the functional layers without the communication previously having to pass through the first layer.” (Final Office Action at 5.) In particular, the Final Office Action cites the Chang Abstract as reciting “the logic for devices to communicate with each other without an intervening physical layer thereby eliminating the connection to the physical layer in a system having multiple layers as in claims 1 and 6.” (*Id.*)

The Chang Abstract clearly limits the communication of link layer information without an intervening physical layer to **internal** communications only. (Chang at Abstract.) If the Chang device is to communicate with **external** devices, it must use a PHY block (i.e. a **physical layer**). (*Id.*) Accordingly, the Chang Abstract does not teach or suggest allowing a test apparatus to communicate with any layer that is higher than a first layer of the functional layers without the communication previously having to pass through the first layer because Chang requires the use of physical layer (PHY) to communicate with external devices. (*Id.*)

The detailed description of Chang further supports this distinction from the pending claims. Chang’s discussion at column 3, lines 32-60, which references Figure 4A, teaches that **internal** link layers 410 can communicate with **internal** split device 500, but PHY (physical layer device) 402 must be used to communicate with **external** devices (such as a test apparatus).

Applicant has previously presented these arguments in the Response to Non-Final Office Action dated May 27, 2008 at pages 4-5. The "Response to Arguments" in the Final Office Action does not address the clear requirement in Chang that external communication of link layer information (i.e. with a test apparatus) requires a physical layer (PHY). (Final Office Action at 2.)

In view of the above, Applicants respectfully request allowance of the present invention.

Respectfully submitted,

October 20, 2008

Date

/Michael J. Fogarty, III/

Michael J. Fogarty, III
Attorney for Applicants
Reg. No. 42,541

SLATER & MATSIL, L.L.P.
17950 Preston Rd., Suite 1000
Dallas, Texas 75252
Tel.: 972-732-1001
Fax: 972-732-9218